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In re Application of:

JONES, David, H.A., et al.	:	DECISION ON RENEWED
Application No.: 10/644,256	:	PETITION
Filing Date: August 20, 2003	:	(37 CFR 1.78(a) and 1.55(c))
Attorney's Docket No.: 2578-6077US	:	

In decisions mailed herein on 30 September 2008, 21 April 2009, 09 March 2010, and 23 August 2010, applicants' petitions under 37 CFR 1.78(a)(3) and (a)(6) and 37 CFR 1.55(c) were dismissed without prejudice for failure to satisfy all the requirements of a grantable petition. The most recent decision found that applicants' proposed amendment to the specification containing the required references to the prior-filed applications could not be entered because a final Office Action had been issued and the examiner had indicated that the proposed amendment would not be entered.

• On September 01, 2010, applicants filed a "Request For Continued Examination (RCE)" accompanied by, among other materials, the "Renewed Petition Under 37 C.F.R. §§ 1.78(a)(3), 1.78(a)(6), and 1.55(c) For Acceptance Of Unintentionally Delayed Priority Claims" and the "Amendment Under 37 C.F.R. § 1.114" considered herein.

On 21 December 2010, applicants filed a "Supplemental Amendment."

1. Renewed Petition Under 37 CFR 1.78(a)(3) and (a)(6) Regarding Claims To Prior-Filed International And Provisional Applications

Applicants are seeking to add to the present application unintentionally delayed claims of domestic priority directed to international applications PCT/EP2003/007690 and PCT/EP03/50201 and to U.S. provisional application number 60/397,066. As discussed in the previous decisions, such petition is properly considered under 37 CFR 1.78(a)(3) and (a)(6).

A grantable petition under 37 CFR 1.78(a)(3) and 1.78(a)(6) must be accompanied by the following:

- (1) the reference required by 35 U.S.C. 120 and 119(e) and 37 CFR 1.78(a)(2)(i) and 1.78(a)(5)(i), unless previously submitted;
- (2) the surcharge set forth in § 1.17(t); and
- (3) a statement that the entire delay between the date the claim was due under 37 CFR 1.78(a)(2)(ii) and 1.78(a)(5)(ii) and the date the claim was filed was unintentional. The Commissioner may require

additional where there is a question whether the delay was unintentional.

The present petition complies with the requirements for a grantable petition under 37 CFR 1.78(a)(3) and (a)(6). Specifically, a proper reference to the prior-filed international and provisional applications is included in the "Supplemental Amendment" filed 21 December 2010.¹ Applicants have previously submitted payment of the required surcharge, and the petition includes a proper statement of unintentional delay. Accordingly, having found that the petition for acceptance of the unintentionally delayed claims for the benefit of priority under 35 U.S.C. 120 and 119(e) to the prior filed applications satisfies the conditions of 37 CFR 1.78(a)(3) and (a)(6), the petition is appropriately granted.

2. **Renewed Petition Under 37 CFR 1.55(c) Regarding Claim To Foreign Application EP 02077953.4**

The decision mailed on March 09, 2010 dismissed applicants' petition under 37 CFR 1.55(c) to add an unintentionally delayed foreign priority claim directed to EP 02077953.4, but the decision indicated that all but one of the conditions necessary to grant the petition were satisfied. Specifically, the decision found that (on the record at the time of such decision) the petition could not be granted because the effective filing date of the present application (August 20, 2003) was not within twelve months of the filing date of the foreign application (July 18, 2002).

Now, however, based on the granting of applicants' accompanying petition under 37 CFR 1.78(a)(3), the present application includes intermediate claims of domestic priority directed to international applications PCT/EP2003/007690, filed July 15, 2003, and PCT/EP03/50201, filed May 27, 2003. Because the filing dates of these domestic priority applications are less than twelve months after the July 18, 2002 filing date of the foreign application, the final requirement for granting the petition under 37 CFR 1.55(c) is now satisfied. The renewed petition to add a foreign priority claim directed to EP application number 02077953.4 is therefore appropriately granted.

CONCLUSION

Based on the above, the renewed petitions under 37 CFR 1.78(a)(3), (a)(6), and 1.55(c) are appropriately **GRANTED**.

The granting of the petition to accept the delayed benefit claim to the prior-filed applications under 37 CFR 1.78(a)(3) and (a)(6) and 1.55(c) should not be construed as meaning that this application is entitled to the benefit of the filing date of the prior-filed applications. In order for this application to be entitled to the benefit of the prior-filed application, all other requirements under 35 U.S.C. 119(a)-(d), 120 and 119(e) and 37 CFR

¹ It is noted that the materials filed by applicants on May 17, 2010 with respect to international application PCT/EP03/50201, including the copy of such application, resolved the defect in the priority reference to such international application discussed in the decision mailed on March 09, 2010.

1.78(a)(1), (a)(2), (a)(5), and (a)(6) must be met. Similarly, the fact that the Filing Receipt accompanying this decision on petition will include the prior-filed applications should not be construed as meaning that applicant is entitled to the claim for benefit of priority to the prior filed applications noted thereon. Accordingly, the examiner will, in due course, consider this benefit claim and determine whether this application is entitled to the benefit of the earlier filing date.

A corrected Filing Receipt, which includes the priority claims to the prior-filed international, provisional, and foreign applications accompanies this decision on petition.

Any questions concerning this decision may be directed to the undersigned. All other inquiries concerning either the examination procedures or status of the application should be directed to the Technology Center.

This matter is being referred to Technology Center Art Unit 1636 for further examination and for appropriate consideration by the examiner of applicants' entitlement to the added benefit claims under 35 U.S.C. 119(a)-(d), 120 and 119(e).

/RichardMRoss/

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ATTACHMENT: Corrected Filing Receipt